



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,073	09/03/2003	Shigeaki Nimura	241966US2 DIV	2009
22850	7590	10/19/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PAIK, STEVE S	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

18

Office Action Summary	Application No.		Applicant(s)	
	10/653,073		NIMURA ET AL.	
	Examiner		Art Unit	
	Steven S. Paik		2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 5 and 7 is/are rejected.
- 7) ☒ Claim(s) 4, 6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/3/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Amendment filed July 29, 2004. The amendment cancelled claims 1 and 2 without prejudice and added new claims 3-8.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 3, 5, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Dymetman et al. (US 6,330,976).

Re claim 3, Dymetman discloses an image information management system, comprising:

a server apparatus (col. 6, ll. 55-65, col. 16, ll. 12-50 and 610 in Fig. 9);

a client apparatus (602 in Fig. 9. connected to the server apparatus via a network (wired or wireless communication network); and

a pen-type information input apparatus (image capture device 506), wherein the server apparatus includes:

a storage part configured to store document information and position identification code management information (col. 16, ll. 47-50);

Art Unit: 2876

a determination part configured to determine whether there is a position identification code assignable to a document to be printed on a paper medium when information on the document and an instruction to perform position identification code printing on the paper medium are received from the client apparatus (col. 16, line 12- col. 33, line 57); and

a transmission part (wired or wireless communication network) configured to transmit the position identification code to the client apparatus when the determination part (CPU 608) determines that there is the position identification code assignable to the document; and

the information input apparatus includes:

an apparatus main body (Fig. 8) configured to be held by a human hand for a writing operation;

an image reading unit (802) configured to optically read the position identification code printed on the paper medium, the image reading unit being provided to the apparatus main body; and

a detection unit (CPU 808 communicating with memory 809 which contains image decoding software along other software) configured to detect position information indicating a position on the paper medium from the read position identification code, the detection unit being provided to the apparatus main body.

Re claim 5, Dymetman discloses an image information management method, comprising:

(a) determining, by a server apparatus (510), whether there is a position identification code assignable to a document to be printed on a paper medium when

Art Unit: 2876

information on the document and an instruction to perform position identification code printing on the paper medium are received from a client apparatus (602) connected to the server apparatus via a network;

(b) transmitting, by the server apparatus, the position identification code to the client apparatus when said step (a) determines that there is the position identification code assignable to the document (col. 16, line 12- col. 33, line57);

(c) optically reading, by a pen-type information input apparatus (506), the position identification code printed on the paper medium; and

(d) detecting, by the information input apparatus (image decoding software and CPU), position information indicating a position on the paper medium from the read position identification code.

Re claim 7, Dymetman discloses a server apparatus for image information management, comprising:

a storage part configured to store document information and position identification code management information (col. 16, ll. 47-50);

a determination part configured to determine whether there is a position identification code assignable to a document to be printed on a paper medium when information on the document and an instruction to perform position identification code printing on the paper medium are received from a client apparatus connected to the server apparatus via a network (col. 16, line 12- col. 33, line57); and

a transmission part (via wired or wireless communication network) configured to transmit the position identification code to the client apparatus when the determination

Art Unit: 2876

part determines that there is the position identification code (pid and location code) assignable to the document.

Allowable Subject Matter

4. Claims 4, 6, and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior arts of the records discloses, teaches, or fairly suggests the claimed features comprising, among other things, a correction information determination part configured to determine whether correction information transmitted from the information input apparatus pertains to the document managed by the server apparatus; and a correction part configured to correct the document based on the correction information when the correction information determination part determines that the correction information pertains to the document managed by the server apparatus.

Response to Arguments

6. Applicant's arguments with respect to claims 3-8 have been considered but are moot in view of the new ground(s) of rejection. The newly added claims , 3, 5, and 7 are rejected under 35 U.S.C. § 102 (e) as being anticipated by Dymetman et al. (US 6,330,976).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 2876

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/653,073

Page 7

Art Unit: 2876



Steven S. Paik
Primary Examiner
Art Unit 2876

ssp